IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Michael YEADON, et al. Examiner: Yong Soo Chong

Serial No.: 10/720,050 Group Art Unit: 1617

Filed: November 19, 2003 Confirmation No.: 3489

Title: COMBINATION OF A DOPAMINE D2-RECEPTOR AGONIST AND TIOTROPIUM OR A DERIVATIVE THEREOF FOR TREATING OBSTRUCTIVE AIRWAYS AND OTHER INFLAMMATORY DISEASES

PETITION TO COMMISSIONER UNDER 37 C.F.R. §1. 181 FOR WITHDRAWAL OF RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition the Commissioner under 37 C.F.R. §1.181 for withdrawal of the restriction requirement outstanding in this application.

Point to be Reviewed

Whether the Restriction Requirement outstanding in this application is proper.

Statement of Facts

The Restriction Requirement is set forth in two Office Actions mailed June 21, 2007, and October 29, 2007. After applicants made their election and traversal of the initial restriction requirement in a Reply filed August 21, 2007, the Examiner decided that the first restriction was not restrictive enough and made an even more restrictive requirement. Applicants responded to the second action in a Reply filed November 29, 2007, maintaining

their previous traversal and submitting further traversal of the new restrictions. Applicants have maintained their traversal of the restriction requirements throughout this prosecution. The restriction was made Final in the Office Action mailed February 14, 2008.

The first restriction was made between: Group I, claims 1-11 and 20-34, drawn to compositions; Group II, claims 12-19, drawn to methods of treating asthma using the compositions of Group I; Group III, claims 12-19, drawn to methods of treating COPD using the compositions of Group I; and Group IV, claims 12-19, drawn to methods of treating obstructive airway diseases other than asthma of COPD using the compositions of Group I. Additionally, for each of Groups I-IV a further restriction was made between 23 different groups of dopamine D2-receptor agonists. Thus, the claims were restricted into 92 different groups of invention. The reason given in the Office action for restriction of Group I from Groups II-IV was that the inventions were related as product and process of use and that there were other known methods for treating obstructive airways diseases. The reason given for restriction of Groups II-IV from each other was that the inventions are unrelated. No reason at all was given for the initial restriction among the 23 different groups of dopamine D2-receptor agonists.

Additionally, in the first restriction requirement, the Groups I-IV were set forth only in relation to embodiments where the tiotropium anti-cholinergic is of the configuration of formula (1.1.1). No option to elect species where the tiotropium anti-cholinergic is of a different configuration was set forth or allowed.

In the second restriction requirement, one of the groups of dopamine D2-receptor agonists was additionally restricted into 27 different groups, each directed to a specific dopamine D2-receptor agonist species. <u>With this additional restriction, the claims are now restricted into 196 different groups of invention.</u> The reason given for this additional

restriction was that the individual species of dopamine D2-receptor agonists are unrelated.

In making the second restriction requirement, no response was provided to applicants arguments in traversal to the first restriction requirement, even though the first restriction requirement still applies in addition to the second. Further, in response to applicants' argument that the tiotropium anti-cholinergic was limited to the configuration of formula (1.1.1) without any choice given to applicants, the Office action alleged that applicants elected this configuration so there was no longer any issue.

In the current Office action mailed February 14, 2008, the Examiner dismissed applicants' traversals of the restriction among 49 different groups of dopamine D2-receptor agonists on the grounds that the dopamine D2-receptor agonists do not share a common structural core and that a proper Markush group cannot contain more than one patentably distinct compound. Regarding the restriction of Group I from Groups II-IV, the Examiner reiterated the previous position that there are other known methods for treating asthma and obstructive airways diseases.

Applicants' Arguments

Applicants respectfully urge that the restriction between the 49 different groups of dopamine D2-receptor agonists be withdrawn. No proper basis for restricting between original set forth Groups A-W or between the additional set forth Groups A to AA within original Group A has been provided. The Examiner alleges that these Groups of dopamine D2-receptor agonists are unrelated. Applicants strongly disagree. Such allegation is completely contrary to applicants' disclosure, even applicants' claims, and the knowledge of one of ordinary skill in the art. As the disclosure and claims make clear, all of the compounds restricted in original Groups A – W and later additional Groups A to AA, within original

Group A, are dopamine D2-receptor agonists. They are clearly not "totally different compounds," as alleged in the Office action mailed October 29, 2007. Further, there is no basis to assert that they have different modes of operation, different effects and different function. To the contrary, they are all used in the invention for the same mode of operation, effect and function, i.e., to provide dopamine D2-receptor agonist activity. Merely because some of these compounds lack a common structural core does not support that they should be restricted among each type of species. Further, applicants disagree that a proper search will not lead to information on each member of the group. The proper search should look for dopamine D2-receptor agonists, which will include all of the compounds.

In any event, restriction among original Groups A-W, and new Groups A to AA within original Group A, is not supportable. Claim 1 is a proper Markush group. A Markush claim **can** contain independent and distinct inventions such that a prior art reference anticipating the claim with respect to one member would not render the claim obvious with respect to another member. The PTO's own rules on this matter set forth in M.P.E.P. §803.02 specifically state that:

> "A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. §103 with respect to the other member(s)."

This section of the M.P.E.P. makes clear that such a claim is a proper Markush claim and should be examined in accordance with Markush practice. This section of the MPEP also states:

> "The members of the Markush group (A, B, and C in the example above) ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is

> sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property." (Emphasis added)

Here all the species clearly belong to the art-recognized class, i.e., the embodiments encompassed by Groups A-W (and additional Groups A to AA) are all dopamine D2-receptor agonists, as claim 1 makes clear. Further, the claims are clearly directed to a combination and the dopamine D2-receptor agonists, by definition, have the common property of dopamine D2-receptor agonist activity, as mainly responsible for their function in the claimed relationship. The claims fall directly into the definition of a proper Markush claim provided by the PTO's own practice rules and should not be subject to restriction. Additionally, M.P.E.P. §2173.05(h) discusses types of improper Markush claims and applicants' claims are not of the type indicated to be improper therein. Accordingly, it is respectfully submitted that the instant claims are proper Markush claims and, therefore, restriction is not proper.

Applicants further traverse the restriction on the grounds that there is no undue burden of search to include all the dopamine D2-receptor agonists. To the contrary, the PTO is placing an extremely undue burden upon applicants by making this restriction requirement. Coupled with the initial restriction, the current restriction requirement restricts this invention into 196 Groups (i.e., the initial four groups I-IV, times the 23 different initially restricted groups of dopamine D2-receptor agonists plus the 27 new different specific dopamine D2-receptor agonists). Thus, if the restriction is proper, the PTO is asserting that applicants will have to file 196 different applications (**at a cost of over $200,000**, just for the filing costs) to cover their single unitary invention here. The invention is directed to the unitary invention of the combination of the specific tiotropium anticholinergic with a dopamine D2-receptor agonist and specific methods for using such combination. Such a reasonable targeted

invention does not warrant the extreme restriction imposed here.

Applicants further traverse and request withdrawal of the original restriction because the restricted Groups for election set out in the initial action do not encompass the full scope of the claims. The Groups I-IV only relate to embodiments where the tiotropium anti-cholinergic is of the configuration of formula (1.1.1). However, the invention is not so restricted and the Groups for election do not encompass other embodiments using other anti-cholinergics; see, e.g., claims 6-10. Thus, the restriction should be withdrawn because it fails to consider the full claimed invention. Applicants submit that there is no basis to restrict among the separate configuration formulas of tiotropium and no basis for such a restriction has even been presented by the Examiner.

Applicants also traverse the restriction of Groups II-IV from Group I. Groups II-IV are directed to the method of use of the compositions of Group I. As the basis for restriction, both Office Actions setting forth the restrictions alleged that, "another method of treating obstructive airway disease, such as asthma, is environmental management to avoid asthma triggers and an established drug regimen including bronchodilators." However, such allegation does not support restriction among composition and method of use claims. The fact that the condition can be treated by a different method does not meet one of the requirements for supporting restriction, i.e., (1) the process can be practiced with a materially different product, or (2) the product can be used in a materially different process. As for (1), using a different product would not result in the claimed method because there is no evidence to support that a different product would provide the materially same effect. As for (2), there is no evidence to suggest the product can be used in a materially different process. For this reason, at least, there is no proper basis for restriction.

Further, the processes of Groups II-IV are within the same genus, i.e., treatment of

obstructive airway other inflammatory diseases. Claim 12 is generic to each of the alleged Groups II-IV, which is why claims 13-19 are all ultimately dependent on claim 12. No proof or objective evidence is provided to support that the Groups II-IV are directed to materially different processes. Thus, it is not correct that the inventions of Group II-IV are "unrelated." Clearly they are related since each is within the genus of methods for treatment of obstructive airway other inflammatory diseases. A cursory review of the prior art in the field evidences the close relation between methods of treating asthma and COPD.

Accordingly, it is urged that the restriction of Groups II-IV from Group I and from each other is not supported on the record and should be also be withdrawn.

For all of the above reasons, it is urged that the restriction requirement should be withdrawn, in total.

Action Requested

Applicants request withdrawal of the Restriction Requirement, as a whole, which is outstanding in this application. Favorable action is earnestly solicited.

Respectfully submitted,

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